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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,608	07/29/2003	Anthony F. Whitemiller		5825

23121 7590 12/28/2006  
THE LAW FIRM OF HARRIS & BURDICK  
HAROLD BURDICK AND ROBERT HARRIS  
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SUITE E  
BOULDER, CO 80301

EXAMINER
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PRONE, JASON D

ART UNIT	PAPER NUMBER
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3724

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/28/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/628,608	WHITEMILLER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jason Prone	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-13 is/are allowed.
- 6) ☒ Claim(s) 1-6, 14-16 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The indicated allowability of claims 14-16 and 18-20 is withdrawn in view of the newly discovered reference(s) to Collins (5,581,834). Rejections based on the newly cited reference(s) follow.

#### ***Claim Objections***

2. Claim 2 is objected to because of the following informalities: On line 10, the term "expansive" is not correct. The head portion cannot expand and therefore cannot be expansive relative to anything. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites the limitation "said saw blade" on line 2. There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1, 4, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldwitz (4,993,093) in view of Collins (5,581,834) and Canino (4,890,387).

Goldwitz discloses the invention including first and second housing portions forming a mount (20), the mount having a path defined therein by the first and second housing portions with the path terminating at an open end between the first and second housing portions at one end of the mount (22 and 24), a tape measure blade receiving slot defined in the mount by the first and second housing portions and located in said one end of the mount (30), a knife blade shuttle selectively movable along the path defined at the mount (24), and the slot and path are oriented relative to one another in a substantially coplanar relationship (Fig. 1).

However, Goldwitz fails to disclose first and second resilient clips at the first and second housing portions adjacent to the slot and configured to cooperatively grip a tape measure blade received in the slot, a saw blade pivotably connected in an opposite end of the mount, and at least one of the first and second housing portions includes an exterior surface with a plurality of rasp teeth.

Collins teaches it is old and well known for receiving slots to incorporate first and second resilient clips at the first and second housing portions adjacent to the slot and configured to cooperatively grip an item received in the slot (Column 6 lines 21-25). Collins teaches the idea of a receiving slot incorporating resilient clips to snugly engage a received item. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the slot of Goldwitz with resilient clips, as taught by Collins, to better grip the end of the tape measure.

Canino teaches that it is old and well known in the art of utility knives to incorporate a saw blade pivotably connected in an opposite end of the mount (31) and at least one of the first and second housing portions includes an exterior surface with a plurality of rasp teeth (16a). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Goldwitz with the saw blade and rasp teeth, as taught by Canino, to make the tool more versatile.

7. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldwitz in view of Collins and Canino as applied to claim 1 above, and further in view of Thomas III (Des. 238,247). Goldwitz in view of Collins and Canino disclose the invention including the mount has a head portion at said one end of the mount (Fig. 1 in Goldwitz) and a handle portion (21 in Goldwitz), and the slot being located through the head portion of the mount (30 in Goldwitz).

However, Goldwitz in view of Collins and Canino fail to disclose the head portion is enlarged in at least one dimension relative to the handle portion, an angularly diverging head portion with a surface area that is expansive to the width of the handle portion, and the surface area is curvilinear and is characterized by surface irregularities.

Thomas III teaches that is old and well known in the art of utility knives to incorporate head portion that is enlarged in at least one dimension relative to the handle portion, an angularly diverging head portion with a surface area that is expansive to the width of the handle portion, and the surface area is curvilinear and is characterized by surface irregularities (Figs. 1 and 2). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Goldwitz in view of

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Collins and Canino with the head portion, as taught by Thomas III, to allow the knife to fully support a broader finger.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldwitz in view of Collins and Canino further in view of Thomas III (Des. 238,247) as applied to claims 1 and 2 above, and further in view of Huang (US 2002/0124411). Goldwitz in view of Collins and Canino further in view of Thomas III disclose the invention including the shuttle includes a blade holding portion (Fig. 4 in Goldwitz) and a manipulable portion extending away from the blade holding portion and accessible at the mount at a position spaced from the head portion (24 in Goldwitz).

However, Goldwitz in view of Collins and Canino further in view of Thomas III fail to disclose a lock-out means in the mount and cooperative with the manipulable portion for prohibiting movement of the shuttle in a preselected circumstance.

Huang teaches it is old and well known in the art of utility knives to incorporate a lock-out means in the mount (151) and cooperative with the manipulable portion (322) for prohibiting movement of the shuttle in a preselected circumstance (Page 2, lines 7-9 of paragraph [0023]). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Goldwitz in view of Collins and Canino further in view of Thomas III with a lock-out means, as taught by Huang, to prevent the blade from moving to the extended/working position at an unwanted time.

9. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldwitz in view of Collins. Goldwitz discloses the invention including first and second housing portions forming a mount (20), the mount having a path defined therein

by the first and second housing portions with the path terminating at an open end between the first and second housing portions at one end of the mount (22 and 24), a tape measure blade receiving slot defined in the mount by the first and second housing portions and located in said one end of the mount (30), a knife blade shuttle selectively movable along the path defined at the mount (24), and at least one of the housing portions includes at least a first guideway (24), wherein the knife blade shuttle includes a guide (Fig. 1), and the guideway and the guide cooperatively contain the movement of the knife blade shuttle (Fig. 1).

However, Goldwitz fails to disclose first and second resilient clips at the first and second housing portions adjacent to the slot and configured to cooperatively grip a tape measure blade received in the slot.

Collins teaches it is old and well known for receiving slots to incorporate first and second resilient clips at the first and second housing portions adjacent to the slot and configured to cooperatively grip an item received in the slot (Column 6 lines 21-25). Collins teaches the idea of a receiving slot incorporating resilient clips to snugly engage a received item. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the slot of Goldwitz with resilient clips, as taught by Collins, to better grip the end of the tape measure.

10. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldwitz in view of Collins as applied to claim 14 above, and further in view of Canino. Goldwitz in view of Collins disclose the invention but fail to disclose an exterior surface of the mount has a plurality of rasp teeth formed transversely at one of the housing

portions, a saw blade mounted at one of the housing portions at the interior of the mount, and the saw blade is pivotable from a stored orientation within the mount to a fully extended orientation through an elongated space defined between the housing portions.

Canino teaches that it is old and well known in the art of utility knives to incorporate an exterior surface of the mount has a plurality of rasp teeth formed transversely at one of the housing portions (16a), a saw blade mounted at one of the housing portions at the interior of the mount (31), and the saw blade is pivotable from a stored orientation within the mount to a fully extended orientation through an elongated space defined between the housing portions (Fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Goldwitz in view of Collins with the saw blade and rasp teeth, as taught by Canino, to make the tool more versatile.

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldwitz in view of Collins further in view of Canino as applied to claims 14 and 20 above, and further in view of Huang. Goldwitz in view of Collins further in view of Canino disclose the invention including the knife blade shuttle includes a blade holding portion (Fig. 1 in Goldwitz) and a manually manipulable portion extending away from the blade holding portion (24 in Goldwitz).

However, Goldwitz in view of Collins further in view of Canino fail to disclose one of the first and second housing portions include a plurality of detents positioned to be adjacent to the path, the manipulable portion having a resilient arm between the blade



holding portion and a slide accessible through an access defined by the first and second housing portions, and a dog located between the slide and the arm releasably engageable in the detents.

Huang teaches it is old and well known in the art of utility knives to incorporate one of the first and second housing portions include a plurality of detents positioned to be adjacent to the path (151), the manipulable portion having a resilient arm (32) between the blade holding portion (34) and a slide (321) accessible through an access defined by the first and second housing portions (15), and a dog located between the slide and the arm releasably engageable in the detents (322). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Canino in view of Goldwitz with a detents along with a cooperable knife blade shuttle, as taught by Huang, to prevent the blade from moving to the extended/working position at an unwanted time.

***Allowable Subject Matter***

12. Claims 7-13 are allowed.
13. Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McAlister, Ellenberger, Rowley, Graham, and Kotori.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is (571) 272-4513. The examiner can normally be reached on 7:00-4:30, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

December 18, 2006



Patent Examiner  
Jason Prone  
Art Unit 3724  
T.C. 3700